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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,791	02/28/2002	Etsuo Minamino	Q68612	3936

23373 7590 08/22/2003

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WASHINGTON, DC 20037

EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,791

Applicant(s)

MINAMINO ET AL.

Examiner

Donald R Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6,8,9. 6) ☐ Other:

DETAILED ACTION**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruepping.**

3. Ruepping discloses fluoroelastomer compositions wherein the elastomer contains brominated or iodinated olefins, a multifunctional cross-linking agent and a photoinitiator for UV cross-linking (col. 4, lines 39-65). Bromo- and iodo-containing cure site monomers are disclosed to be preferred (col. 10, lines 37-40), and the amounts of the cure site monomer are taught to be within the range of 0.05 to 10.0 wt.% (col. 11, lines 16-19), which would therefore have bromo or iodine contents within the limits of the instant claims. Ruepping also teaches that the compositions are useful for the manufacture of seals and gaskets (e.g., col. 18, lines 17-21), which makes gaskets from the compositions readily envisaged. The reference does not specifically teach use of the gaskets for magnetic disc production. However, this is an intended use giving no specific structure to the gasket, and is not seen to impart patentability to the claims.

Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.) See M.P.E.P. § 2111.03.

4. **Claims 1-4, 8 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Li, as evidenced by JP'491 or JP'310.**

5. Li discloses compositions comprising a multifunctional acrylate, a photoinitiator (camphorquinone) and an iodine containing fluoroelastomer (see Example 1). Although Li itself doesn't specifically disclose the iodine content of the fluoroelastomer, JP'491 and JP'310 are taught to be examples of the

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fluoroelastomer (sentence bridging col. 1 and col. 2). As may be seen from the English language abstracts of JP'491 or JP'310, the iodine or bromine content is within the limits of the instant claims. Thus, one of ordinary skill in the art would have readily envisaged iodine contents of the fluoroelastomers taught in the compositions of Li to have bromine or iodine contents in amounts such as in the instant claims. Photopolymerization of the compositions by ultraviolet rays is specifically taught (col. 3, lines 47-52).

6. **Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Merrill'048.**

7. Merrill'048 discloses the preparation of compositions cross-linked by UV radiation comprising a polymer containing a bromine atom, a polyunsaturated monomer and a photoinitiator (see Claims 9, 16-17, 19 and 21-23). In regards to the bromine content, in as much as the reference specifically teaches the inclusion of dibromopropyl acrylate (Claims 17), and a block copolymer containing 60 to 90 wt.% coacrylate of which about 5 to about 50 wt.% of the bromoacrylate, compositions with a bromine content within the limits of the instant claims would have been readily envisioned.

Art of Interest/Technological Background

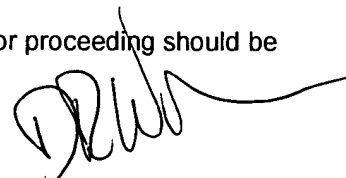
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Merrill'194 and '582 are part of the same patent family as Merrill'048 and the teachings are therefore considered to be cumulative.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R. WILSON
PRIMARY EXAMINER